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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,304	04/27/2001	Phillip Clark	MCA-500 US	1202

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/03/2002

57

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/844,304

Applicant(s)

CLARK ET AL.

Examiner

Krishnan S Menon

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 12, 14, 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to product, multi-well filter, classified in class 210, subclass 483.
- II. Claims 18-23, drawn to process of making the multi-well filter, classified in class 210, subclass 321.61.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other materially different products like other types of filters and filter applications, and the product as claimed can be made by other materially different processes like solvent welding, ultrasonic welding, etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. John Dana Hubbard, attorney for the applicant on 9/9/02 a provisional election was made without traverse to prosecute the invention of group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 7, 10, 11, 13, 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Clark et al (US 5,223,133).

Clark (133) discloses a multi-well filter plate comprising a plate (12-Fig 1) having a top and bottom surface, a plurality of holes through the plate, a filter having a first and second surface (23-fig 3), the first surface of the filter sealed to the bottom surface of the plate (19-fig 3) by an adhesive (col 4 lines 18-23, 60-69), seal being leak tight and the liquid passes through the filter on applying a pressure differential (col 3 lines 60-63) as in instant claim 1. Filter is selected from microporous or ultrafiltration membranes (instant claim 2, 16, 17) and cellulose, polyamide, polysulfone, etc, (instant claim 11) (col 4 lines 22-40). The material for the plate can be of ABS, polystyrene, etc (instant claim 10, 13) (col 4 lines 42-46; lines 9-12), the adhesive can be light or thermally activated (lines 62-64) (instant claim 7).

2. Claims 1, 4, 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Matkovich et al (US 4,797,259).

Matkovich discloses a 96 array well filter (instant claim 5) (col 1 lines 30-33) on a plate with filter adhesively bonded to the bottom of the well (col 12 lines 45-60) (instant claim 1), the well could be of circular, square or other shapes (instant claim 4) ( 3 lines 12-16), and the filter supported from the bottom with a director sheet and spout (15,29-Fig 3) (instant claim 8,9). The 384 well plate is only a further replication of the 'plurality of wells' in the plate like the 96 well plate (instant claim 6).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (US 5,223,133) in view of Fernwood et al (US 5,141,719).

Clark (133) discloses a multi-well filter plate comprising a plate (12-Fig 1) having a top and bottom surface, a plurality of holes through the plate, a filter having a first and second surface (23-

Art Unit: 1723

fig 3), the first surface of the filter sealed to the bottom surface of the plate (19-fig 3) by an adhesive (col 4 lines 18-23, 60-69), seal being leak tight and the liquid passes through the filter on applying a pressure differential. Clark (133) is silent on the parts being made by injection molding or punching plastic sheets, and on the pour spout on the director sheet (instant claim 9). Fernwood (5,141,719) teaches a multi-well filter with a director sheet having spouts (15-fig 1) with injection molded plastic parts (5 lines 33-40). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Fernwood (719) in the multi-well filter of Clark (133) as alternate but equivalent construction for equivalent function.

### *Allowable Subject Matter*

Claims 12, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zermani (US 6,309,605) teaches multi-well filter with filter bonded by adhesives. Clark (US 4,902,481) teaches multi-well filter having filter bonded with adhesives, with director sheet having pour-spout.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

Art Unit: 1723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan S. Menon  
Patent Examiner  
September 26, 2002

  
W. L. WALKER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700